

REMARKS

Claims 1-2, 5, 7, 9, 17, 29-30, 48-58, and 60 are pending in this application. In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

In particular, independent claims 1 and 30 have been rewritten to further clarify the embodiments of the present invention recited therein. In addition, various dependent claims have been rewritten or canceled (claims 4 and 59) to maintain consistency with the language now recited in the independent claims. Finally, new claims 61-64 have been added to recite additional embodiments of the invention fully supported by the Written Description. For example, new claim 61 is a combination of the subject matter previously recited in claims 1 and 5 and new claim 63 is a combination of the subject matter previously recited in claims 1 and 2, which the Examiner indicated to be allowable. Office Action at Page 8.

As no new matter has been added, Applicants respectfully request entry of these remarks at this time.

ALLOWABLE SUBJECT MATTER

Applicants appreciate the Examiner's recognition of allowable subject matter in claims 2 and 5 if rewritten in independent form. In addition, Applicants appreciate the Examiner's recognition of allowable subject matter in claims 7 and 9 if rewritten to overcome the § 112 rejection and to include the subject matter recited in the independent claim (and any intervening claims). In response, new claims 61 and 63 have been added to include the subject matter previously recited in claims 1 and 5 and claims 1 and 2, respectively.

THE REJECTION UNDER 35 U.S.C. § 112

Claims 7 and 9 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for the reasons provided on page 2 of the Office Action. In response, claim 7 has been rewritten to depend from claim 1. Thus, Applicant respectfully submits that the § 112 rejection has been overcome. Reconsideration and withdrawal of the rejection is respectfully requested.

THE REJECTION UNDER 35 U.S.C. §§ 102 & 103

Claims 1, 4, and 17 were rejected under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 4,301,110

to Cuscurida *et al.* for the reasons provided on pages 3-4 of the Office Action.¹ In addition, the Examiner rejected claims 30 and 55-57 under § 103(a) as being obvious over Cuscurida as provided on pages 4-5 of the Office Action. The Examiner also rejected claim 54 under § 103(a) as obvious over Cuscurida in view of U.S. Patent No. 4,288,586 to Bock *et al.* as stated on pages 5-6 of the Office Action. Finally, claims 29, 48-53, and 58-60 were rejected under § 103(a) as obvious over Cuscurida in view of U.S. Patent No. 6,174,984 to Peter as provided on pages 6-8 of the Office Action.

Cuscurida generally discloses a method for making reaction injection molded (RIM) polyurethanes for use in automobile parts. *See* Abstract; *see also* Col. 1, lines 40-52. In particular, Cuscurida teaches a polyurethane elastomer made with a RIM process that involves an aromatic polyisocyanate, a high molecular weight polyol, and a chain extending agent. Col. 1, lines 55-66. Cuscurida is completely silent as to the use of these elastomers for golf equipment. And, while Cuscurida lists a “variety” of isocyanates that can be used according to the invention, the isocyanates are limited to aromatic compounds, *i.e.*, compounds containing C=C bonds.

In contrast, the invention now recited in claims 1, 29, and 30 feature a first reactable component that is based on an aliphatic isocyanate. As such, Cuscurida does not disclose each and every element recited in the claims. In addition, Cuscurida does not even suggest the use of aliphatic isocyanates in the polyurethane composition. And, as known to those of ordinary skill in the art, the differences between aromatic and aliphatic isocyanates extend beyond the structure and include light stability. Thus, a skilled artisan would not have been motivated to arrive at the presently recited invention absent the use of impermissible hindsight.

With regard to the secondary references cited by the Examiner, the only motivation that a skilled artisan would have had to combine the references in the manner suggested by the Examiner exists through hindsight. Neither Bock nor Peter even suggest the use of polyurethane compositions or components thereof in forming golf equipment. In fact, Bock is limited to a new process for preparing polyisocyanates and is completely silent as to the use of RIM for forming golf equipment. Col. 2, lines 48-54. Peter is similarly silent.

For at least the reasons above, none of these references disclose or suggest the present invention. As such, Applicants respectfully request that the §§ 102 and 103 rejections be reconsidered and withdrawn.

¹ Applicants believe that the rejection should have been based on § 102(b) instead of § 102(e) in light of the issue date of Cuscurida.

CONCLUSION

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Fee Sheet Transmittal is submitted herewith to pay for the additional claims added with this response. No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Bingham McCutchen LLP Deposit Account No. 19-5127, Order No. 20002.0350.

Respectfully submitted,
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